

REMARKS

I. Status of the Claims

Claims 1-71 are pending. Claims 60-71 are withdrawn as directed to non-elected subject matter. Applicant notes that the Office Action Summary indicates that only claims 1-59 are pending and that no claims are withdrawn. Applicant respectfully requests correction on the record in the next office communication summary. No amendments are made herein. Accordingly, there can be no new matter or written description issues raised.

Applicant respectfully acknowledge the Examiner's withdrawal of the 35 U.S.C. § 112, second paragraph rejection of claims 23-24 and 26-27. See Final Office Action at 2. In the Final Office Action, the Examiner maintains the rejection of claims 1-59 on the grounds of non-statutory obviousness-type double patenting over U.S. Patent No. 7,338,534 (the '534 patent), but acknowledges Applicant's intention to file a terminal disclaimer at the time of the indication of allowable subject matter for the pending claims. See Final Office Action at 2.

II. Rejection under 35 U.S.C. § 103(a)

The Examiner rejects claims 1-59 under 35 U.S.C. § 103(a) as being allegedly "unpatentable over" the combination of WO 02/051,369 (WO '369)¹ and U.S. Patent No. 4,927,627 (the '627 patent) for the reasons set forth in the Final Office Action at pages 2-5.

¹ The Examiner's states that "[t]he examiner is relying on English equivalent of WO document, which is PGPUb US 2004/0074015 ('015)." For convenience, Applicant's references to WO '369 will therefore also be to PGPUb US 2004/0074015 (the '015 application).

Applicant respectfully traverses for the following reasons:

In an obviousness determination, the Examiner must consider the reference teachings as a whole, taking into consideration portions that would lead away from the claimed invention. See M.P.E.P. § 2141.02 (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)); see also, *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966) (A prior art reference relied upon in a rejection “must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.”).

A showing that a reference teaches away from the claimed invention can disprove a motivation to combine that reference with others to render the claimed invention obvious. See *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 724, 16 U.S.P.Q.2d 1923 (Fed. Cir. 1990) (affirming judgment that claims directed to a post-foaming shaving gel (“Edge”) were not proven obvious where, even though all the elements in the claimed invention were known in the art, none of the prior art taught the specific combination, the prior art made no suggestion to substitute the claimed water-soluble polymers for the oil-soluble jellifying agent in a shaving gel, and the closest prior art actually discouraged the use of water-soluble polymers in shaving gels, and therefore taught away); see also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose).

Applicant respectfully submits that the references relied upon by the Examiner, when considered as a whole, provide no reason that would have prompted a person of ordinary skill in the art to modify and combine the references in the manner suggested

by the Examiner. In fact, for the reasons set forth below, Applicant submits that the references, when considered in their entirety, include portions that would discourage the modification and combination suggested by the Examiner.

Independent claim 1 of the instant application requires “an oxidizing cream oil-in-water emulsion.” As acknowledged by the Examiner on page 3 of the Office Action, WO ‘369 fails to teach “oxidizing oil-in-water emulsion.” However, the Examiner alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of WO ‘369 to prepare it in the form of cream emulsion because “it is easier to apply the bleaching compositions in the form cream instead of hydrous as the compositions can be applied onto the hair easily and it won’t run off and bleaching the hair can be performed effectively.” Final Office Action at 4.

Applicant respectfully disagrees with this assertion because WO ‘369 teaches away from using any other formulation besides a transparent gel. As the Examiner points out, WO ‘369 notes that compositions in the form of “anhydrous products (powders or creams)” are part of the prior art. Final Office Action at 4; WO ‘369 at [0003]. But WO ‘369 goes on to discourage the use of such prior art compositions, including creams, because “it has also been found that . . . the thickening systems of the prior art do not allow a sufficiently precise application without the composition running or without reductions in viscosity over time.” WO ‘369 at [0011]. WO ‘369 also notes that the prior art systems fail to produce bleaching results that are sufficiently powerful and homogeneous, leaving the hair course. WO ‘369 at [0010]. Instead, as their invention, the WO ‘369 Applicants “discovered, surprisingly, a novel family of thickeners and/or gelling agents for obtaining transparent gels...” WO ‘369 at [0020]

(emphasis added); see *also*, WO '369 at [0001] ("The present invention relates to a gelled oxidizing composition . . . "). WO '369 touts the superiority of transparent gels and notes that cosmetic formulations in the form of transparent gels have been sought for many years and are appreciated by consumers for esthetic reasons and for ease and comfort of use. WO '369 at [0015]. Because WO '369 clearly limits itself to transparent gels and disparages other systems, the disclosure of the WO '369 does not motivate, but actually leads away from the '672 patent, which teaches the use of a cream emulsion. Such a teaching away reveals the absence of a *prima facie* case of obviousness, because a motivation to combine the references is not present. See *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1350, 53 U.S.P.Q.2d 1580 (Fed. Cir. 2000) (district court did not error in finding that a single reference taught away and therefore one of ordinary skill in the art would not be motivated to combine that reference with another reference to render the claimed invention obvious—affirming finding claim was not invalid); see *also Gillette*, 919 F.2d at 724; *Gordon*, 733 F.2d at 902.

In view of the above arguments, Applicant submits that the Examiner has not established a *prima facie* case of obviousness. Thus, the rejection of claims 1-59 under 35 U.S.C. § 103(a) as being unpatentable over the combination of WO '369 and '627, is in error and should be withdrawn.

V. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and timely allowance of the pending claims.

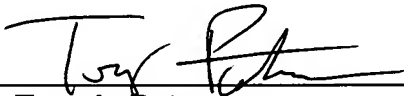
If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is respectfully invited to contact Applicant's undersigned counsel at (202) 408-4443.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 2, 2009

By: 
Troy A. Petersen
Reg. No. 56,827